

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

VERINATA HEALTH, INC., et al.,

Plaintiffs,

v.

ARIOSIA DIAGNOSTICS, INC, et al.,

Defendants.

Case No. [12-cv-05501-SI](#)

ORDER RE: DISCOVERY

Re: Dkt. No. 360, 366, 370, 377

Illumina has provided the Court with a handful of purportedly privileged documents for *in camera* review. *See* Dkt. No. 377. The Court has reviewed these documents and finds as follows:

The emails identified as Entries 611 and 616 are not privileged communications. However, the invention disclosure forms attached to those emails are privileged and have properly been withheld. *See In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 805-06 (Fed. Cir. 2000) (finding invention record protected by attorney-client privilege); *see also In re Queen's Univ. at Kingston*, 820 F.3d 1287 (Fed. Cir. 2016) (extending privilege to non-attorney patent agents). “The privilege ‘exists to protect not only the giving of professional advice to those who can act on it, but also the giving of information to the lawyer to enable him to give sound and informed advice.’” *In re Spalding*, 203 F.3d at 805 (citing *Upjohn Co. v. United States*, 449 U.S. 383, 396 (1981)). “It is enough that the overall tenor of the document indicates that it is a request for legal advice or services.” *Id.* at 806. These disclosure forms were prepared to enable either in-house or outside patent prosecution counsel to offer legal advice as to, *e.g.*, patentability. Similarly, the invention disclosure forms identified as Entries 634 and redacted portions of Entries 2820 and 2821 are also privileged and have properly been withheld. To the extent it has not already done so, Illumina is hereby ordered to produce only the emails, Entries 611 and 616, but may withhold

1 the attached invention disclosure forms. Ariosa's motion seeking production of privileged
2 communications is hereby DENIED in all other respects.

3 **IT IS SO ORDERED.**

4 Dated: July 5, 2017



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6 SUSAN ILLSTON
United States District Judge
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